

REMARKS

Claim Rejections

Claims 1-9 are rejected under 35 U.S.C. § 112, second paragraph. Claims 1-4 and 6-9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Pistay (U.S. 5,344,437) in view of Phillips et al. (U.S. 2,943,621). Claim 5 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Pistay in view of Phillips et al. and further in view of Wang (U.S. 2002/0096097).

Drawings

The Examiner has objected to the drawings under 37 C.F.R. § 1.83(a) insofar as the “pipe opening at a proximate side combined with an opening of said external pocket and a pocket opening disposed at an appropriate position of the other end”, referred to in Applicant’s claim 1, was not illustrated in the figures. Since the term has been deleted from Applicant’s new claims, it is not believed that any drawing corrections are necessary.

Applicant proposes to amend Figures 1 and 2, as illustrated in red on the attached photocopies. In Figures 1 and 2 it is proposed to change the duplicate reference number “12” to read –13–. Approval of the proposed drawing changes is respectfully requested.

Amendments to Specification

Applicant has amended the specification as noted above to cure obvious grammatical and idiomatic inaccuracies. It is believed that the foregoing amendments to the specification overcome the outstanding objections thereto. No “new matter” has been added to the original disclosure by the foregoing amendments to the specification.

New Claims

By this Amendment, Applicant has canceled claims 1-9 and has added new claims 10-16 to this application. It is believed that the new claims specifically set forth each element of Applicant's invention in full compliance with 35 U.S.C. § 112, and define subject matter that is patentably distinguishable over the cited prior art, taken individually or in combination.

The new claims are directed toward a massage pillow comprising: an external pocket (1) having: an interior pocket chamber (13); an external pocket opening (11) in a peripheral wall; and an external latch device (12) selectively opening and closing the external pocket opening; an internal pocket (2) movable into and out of the external pocket and having: a pipe chamber (23) formed in an interior of the internal pocket when the internal pocket is located in the interior of the external pocket, the pipe chamber being movable within the pocket chamber; a pipe opening (21) located in a peripheral wall of the internal pocket aligned with and connected to the external pocket opening; and an internal pocket opening (22) located in a peripheral wall of the internal pocket, the interior pocket chamber communicating with the exterior of the external pocket through the internal pocket opening; a filler (3) inserted into the pocket chamber; and a vibrator (4) inserted into the pipe chamber and being movable between a plurality of predetermined positions within the filler.

Other embodiments of the present invention include: the external pocket and the internal pocket are made of a woven cloth; the filler is made of a plastic polymer material; the external latch device is one of a zipper and an adhesive tape; the internal pocket opening is sewn closed; an internal latch device (24) selectively opening and closing the internal pocket opening; and the internal latch device is one of a zipper and an adhesive tape.

The primary reference to Pistay teaches a massaging pillow including a pillow (10) with a filling (34), a pocket (25) located on an exterior of the pillow, and a cavity (42) formed in an end of the pillow within the filling (34). A vibrator (44) is inserted into the foam filling (34).

Pistay does not teach an internal pocket movable between the interior and an exterior of the external pocket; the pipe chamber being movable within the pocket

chamber; the pocket chamber communicating with the exterior of the external pocket through the internal pocket opening; nor does Pistay teach a vibrator being movable between a plurality of predetermined positions within the filler.

The secondary reference to Phillips et al. teaches a vibrating pillow including a cylindrical wall (17), end walls (14) with an opening (16), a casing (12) inserted through the openings, and a vibrator unit (13) fixed on an interior of the casing.

Phillips et al. do not teach an internal pocket movable between the interior and an exterior of the external pocket; the pipe chamber being movable within the pocket chamber; the pocket chamber communicating with the exterior of the external pocket through the internal pocket opening; nor do Phillips et al. teach a vibrator being movable between a plurality of predetermined positions within the filler.

The secondary reference to Wang teaches a hollow embroidering method and is cited for teaching a film material being a pylon.

Wang does not teach an internal pocket movable between the interior and an exterior of the external pocket; the pipe chamber being movable within the pocket chamber; the pocket chamber communicating with the exterior of the external pocket through the internal pocket opening; nor does Wang teach a vibrator being movable between a plurality of predetermined positions within the filler.

Even if the teachings of Pistay, Phillips et al., and Wang were combined, as suggested by the Examiner, the resultant combination does not suggest: an internal pocket movable between the interior and an exterior of the external pocket; the pipe chamber being movable within the pocket chamber; the pocket chamber communicating with the exterior of the external pocket through the internal pocket opening; nor does the combination suggest a vibrator being movable between a plurality of predetermined positions within the filler.

It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents on the basis of Applicant's disclosure to create a hypothetical combination which allegedly renders a claim obvious, unless there is some direction in the selected prior art patents to combine the selected teachings in a manner so as to negate the patentability of the claimed subject matter. This principle was enunciated over

40 years ago by the Court of Customs and Patent Appeals in In re Rothermel and Waddell, 125 USPQ 328 (CCPA 1960) wherein the court stated, at page 331:

The examiner and the board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure. ... It is easy now to attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill in the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of the claims, it is not the type of rejection which the statute authorizes.

The same conclusion was later reached by the Court of Appeals for the Federal Circuit in Orthopedic Equipment Company Inc. v. United States, 217 USPQ 193 (Fed.Cir. 1983). In that decision, the court stated, at page 199:

As has been previously explained, the available art shows each of the elements of the claims in suit. Armed with this information, would it then be non-obvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the claims in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

In In re Geiger, 2 USPQ2d, 1276 (Fed.Cir. 1987) the court stated, at page 1278:

We agree with appellant that the PTO has failed to establish a *prima facie* case of obviousness. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed

invention, absent some teaching suggestion or incentive supporting the combination.

Applicant submits that there is not the slightest suggestion in either Pistay, Phillips et al., or Wang that their respective teachings may be combined as suggested by the Examiner. Case law is clear that, absent any such teaching or suggestion in the prior art, such a combination cannot be made under 35 U.S.C. § 103.

Neither Pistay, Phillips et al., nor Wang disclose, or suggest a modification of their specifically disclosed structures that would lead one having ordinary skill in the art to arrive at Applicant's claimed structure. Applicant hereby respectfully submits that no combination of the cited prior art renders obvious Applicant's new claims.

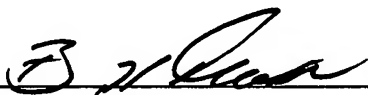
Summary

In view of the foregoing amendments and remarks, Applicant submits that this application is now in condition for allowance and such action is respectfully requested. Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicant's local attorney be contacted at the exchange listed below.

Respectfully submitted,

Date: January 7, 2005

By:



Bruce H. Troxell
Reg. No. 26,592

TROXELL LAW OFFICE PLLC
5205 Leesburg Pike, Suite 1404
Falls Church, Virginia 22041
Telephone: 703 575-2711
Telefax: 703 575-2707

Application No. 10/826,305

IN THE DRAWINGS:

Please amend Figures 1 and 2 as illustrated in red on the attached photocopies.